

REMARKS

Status of Claims

Claims 1-18 are pending. Claims 19-28 were withdrawn from consideration in the Office Action as being directed to a distinct invention from elected claims 1-18. Claims 7-10 and 13-14 were amended by the above amendments without adding new matter. For ease of discussion, claims rejections may be discussed below as if applied even to claims amended above.

Claims 1-18 were rejected under 35 U.S.C. §103(a), (hereinafter, "Section 103(a)") as being unpatentable over Colbert et al. (U.S. Pat. 6,756,026, hereinafter "Colbert").

Affirmation of Election

Applicants affirm the election of claims 1-18.

Information Disclosure Statement

An Information Disclosure Statement, including copies of references, accompanies the present Amendment. Applicants respectfully request that the references of the Information Disclosure Statement be made of record in the present Application.

Section 103(a) Rejections

The Office Action rejected claims 1-18 under Section 103(a) as being unpatentable over Colbert.

Claim 1

Claim 1 recites, among other features, "a radiating-energy source configured to directly heat catalyst on at least one die via simultaneously emitted multiple prongs of radiating energy". The Office Action conceded that "Colbert et al. does not teach multiple radiating energy beams (prongs) or the presence of a die". Applicants respectfully agree.

The Office Action then dispatched this admitted lack in Colbert with only a single statement that “[d]uplication of parts was held to have been obvious. In re Harza 124 USPQ 378.” (Office Action, page 4.)

Applicants respectfully submit that such a conclusory and terse statement of rejection does not give Applicants a fair opportunity to reply. Applicants respectfully point out that “[t]he initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done” (M.P.E.P. §706.02(j)) and that “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply” (M.P.E.P. §706.02(j)). In other words, Applicants respectfully point out that the Examiner has a burden to “establish a *prima facie* case of obviousness” (M.P.E.P. § 2143). The establishment of a *prima facie* case of obviousness, of course, requires that three basic criteria are met:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.
(M.P.E.P. §2143)

Applicant respectfully submit that the Office Action has failed to allege or explain any suggestion or motivation to modify Colbert to provide the missing elements or any reasonable expectation of success. Accordingly, Applicants respectfully submit that claim 1, and therefore also its dependent claims, are allowable over the cited art. Accordingly, Applicants respectfully urge allowance of all pending claims in a subsequent office action.

If, in the subsequent office action, the rejection of claim 1 is still maintained, Applicants respectfully urge that the necessary “teaching or

suggestion to make the claimed combination and the reasonable expectation of success” be specifically pointed out in the cited art or knowledge and/or in an affidavit as required by 37 C.F.R. § 1.104(d)(2). Furthermore, if, in the subsequent office action, the rejection of claim 1 is still maintained, Applicants respectfully urge that the subsequent office action be made not Final, in order to provide Applicants “fair opportunity to reply”, as required by M.P.E.P. §706.02(j).

Further Discussion of Claim 1

Applicants respectfully understand that the Office Action’s single statement (“[d]uplication of parts was held to have been obvious[;] In re Harza 124 USPQ 378.”) that dispatches Colbert’s lack of claim 1’s relevant features is taken from M.P.E.P. §2144.04(VI)(B). However, Applicants respectfully point out that M.P.E.P. §2144.04(VI)(B) does not and cannot substitute for the particularized obviousness inquiry--i.e., the establishment of a *prima facie* case of obviousness as required by 35 U.S.C. §103.

Applicants respectfully point out that a similarly terse rejection based on a similar improper application of *In re Harza* 124 USPQ 378 was deemed not proper by the Board Of Patent Appeals And Interferences (B.P.A.I.) on Oct. 28, 2004 in *Ex parte* Ralf Allner And Thomas Biber, Appeal No. 2004-2131, Application No. 10/016,719. The opinion in support of the appeal decision can be found at “<http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd042131.pdf>” and via the Patent Office’s public Image File Wrapper database for the application in question. The opinion in support of the decision was not written for publication and is not binding precedent of the Board. Nevertheless, its reasoning is informative for the present Application. The opinion states, at pages 6-7:

... All the claims under appeal require several axiparallel spindles. However, this limitation is not suggested by the applied prior art. In that regard, while Bayne does teach a single spindle, neither Bayne nor Joffe teach or suggest using several axiparallel spindles. To supply this omission in the teachings of the applied prior art, the examiner made a determination (final rejection, p. 2) that this

difference would have been obvious to an artisan as a design choice since the use of multiple spindle drives is a duplication of parts which is patentable only if unexpected results are discovered citing to MPEP § 2144.04 and In re Harza 274 F.2d 669, 124 USPQ 378 (CCPA 1960). There is no per se rule that duplication of parts would have been obvious at the time the invention was made to a person of ordinary skill in the art; application of such rule is improper, since it sidesteps the particularized obviousness inquiry required by 35 U.S.C. § 103 and necessarily produces erroneous results. Thus, the examiner's determination that it would have been obvious to an artisan to use multiple spindle drives in Bayne has not been supported by any evidence that would have led an artisan to arrive at the claimed invention.

As can be seen, the above-quoted passage by the B.P.A.I. can be neatly borrowed by Applicants in the present Application. Applicants can apply the logic of the above-quoted passage by replacing the passage's phrase "several axiparallel spindles" or its like or its counterpart with the phrase from Applicants' claim 1 of "a radiating-energy source configured to directly heat catalyst on at least one die via simultaneously emitted multiple prongs of radiating energy" or its like or its counterpart.

Accordingly, Applicants again respectfully submit that the Office Action has failed to fulfill the Examiner's burden to initially establish that claim 1 (and its dependent claims) is prima facie obvious under Section 103(a). Applicants again respectfully urge that claim 1 be allowed in a subsequent office action.

Claims 2-18

Claims 2-18 each depend on, and include all limitations of claim 1. Accordingly, Applicants respectfully submit that these dependent claims are all allowable for at least the same reasons, discussed above, as is claim 1.

Applicants further respectfully submit that the dependent claims are further allowable for the features that they themselves recite. Applicants respectfully point out that these dependent claims, as modified, do recite structural configuration and do not rely merely on intended use for their additional features.

Accordingly, Applicants respectfully urge that claims 2-18 be allowed in a subsequent office action.

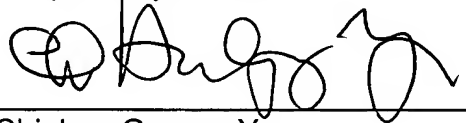
If, in the subsequent office action, the rejections of dependent claims 2-18 are still maintained, Applicants respectfully urge that the necessary associated "teaching or suggestion to make the claimed combination and the reasonable expectation of success" be specifically pointed out in the cited art or knowledge and/or in an affidavit as required by 37 C.F.R. § 1.104(d)(2).

CONCLUSION

Therefore, Applicants submit that their invention is not disclosed, taught, or suggested by the references of record. Therefore, it is submitted that all of the claims are allowable over the art of record and it is respectfully requested that the application be passed to allowance.

Dated: May 16, 2005

Respectfully submitted,



Chiahua George Yu
Reg. No. 43,301
Phone: (858) 793-9282
Fax: (858) 793-9501

Correspondence Address:
Law Offices of C. George Yu
12707 High Bluff Drive
Second Floor; PMB 2008
San Diego, CA 92130